

REMARKS

Claims 1, 5 to 15 and 17 to 19 as amended above are present for purposes of prosecution.

Applicants wish to thank the Examiner for the helpful telephone interview granted to the undersigned attorney of record. During the interview various issues were discussed as outlined below.

1. Applicants' attorney discussed the definition of Y which original was CO_2R^4 where R^4 is H or alkyl.

In the requirement for restriction in Group I, the Examiner defined Y as COOH. However, in view of the following disclosure the Examiner agreed to define Y as COOH or COOalkyl

page 23, Scheme 3, where ester compound 11 is shown;

page 24, Scheme 5, where ester compound 58 is shown;

page 33, Scheme 17, where ester compound 58 is shown;

page 34, Scheme 18, where ester compound 58 is shown;

page 34, Scheme 19, where ester compound 60 is shown; and

page 36, Scheme 22, where ester compound 68 is shown.

In addition please note the working Examples where innumerable ester compounds of the invention are disclosed.

2. Applicants agreed to amend the Abstract (as indicated above) so that it can be included on a single page.

3. Applicants agreed to amend the claims (as indicated above) so that they only encompass elected subject matter.

4. Applicants agreed to cancel Claim 16 but reserve the right to file a continuation application to cover Claim 16.

5. With regard to Claim 15 directed to method of treating diabetes and related diseases, the Examiner indicated that he would consider prior art which disclose compounds having a related structure to the compounds claimed herein and which discloses such compounds for treating diabetes and related diseases. Applicants refer the Examiner to U.S. Patent No. 6,653,314 to Cheng et al. which disclose compounds which are excluded from the present claims but which have

similarities to the compounds claimed herein. Cheng et al. disclose these compounds as being useful for treating all of the diseases in Applicants' Claim 15. Attached are pages 1 and columns 1 to 23 of Cheng et al.

It is submitted that one skilled in the art reading the disclosure of Cheng et al. 6,653,314 and the present application would concur that the present compounds claimed herein should have a similar utility to the compounds of Cheng et al. Also enclosed are page 1 and columns 1 to 6 of U.S. Patent No. 6,506,781 to Cobb et al. which discloses compounds of related structure to the compounds claimed herein for treatment of diabetes.

Claims 1 to 19 are rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement.

The Examiner specifically mentions that the specification on the first page states that "the instant compounds modulate blood glucose levels, triglyceride levels, insulin levels and non-esterified fatty acid levels." The Examiner questions the term "modulation" as including both increases and decreases in the above levels.

In view of the above arguments concerning the Cheng et al., it is believed that this ground of objection has been overcome.

Applicants have disclosed how to make the compounds of the invention as well as how to use them. Applicants have disclosed at page 8 of the Specification that the compounds claimed are useful for treating diabetes and related diseases as well as obesity. Applicants have disclosed dosages and dosage forms at pages 64 and 65 of the Specification. In fact, Applicants have disclosed everything necessary to enable one skilled in the art to carry out and practice the present invention without undue experimentation. The Examiner has not advanced any arguments or cited references which would lead one skilled in the art to doubt Applicants' teachings of how to make and how to use the invention claimed.

The state of the prior art as illustrated by U.S. Patent No. 6,653,314 to Cheng et al. and U.S. Patent No. 6,506,781 to Cobb et al. as well as the references cited in the Information Disclosure Statement as filed as well as the references cited in these prior art references, many of which teach compounds useful for treating diabetes. These references further buttress Applicants' position that the Examiner has no reason to doubt Applicants' disclosure on how to use the compounds claimed.

As set out above, Applicants have fully complied with the disclosure requirements of how to make and how to use their invention so that one skilled in the art may practice the invention claimed without undue experimentation.

The Examiner indicates that

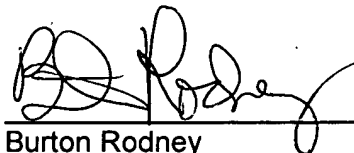
"Claims 1, 3, 5-12 and 14-19 are objected as containing non-elected subject matter."

In view of the amendments to the Claims as set out above, it is believed that Claims 1, 5 to 15 and 17 to 19 no longer contain non-elected subject matter.

Applicants note that the Examiner has indicated that the compounds directed to the elected group I are allowable over the prior art.

In view of the foregoing, it is submitted that Claims 1, 5 to 15 and 17 to 19 overcome all formal objections and cover allowable subject matter and thus are in condition for allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Burton Rodney", is written over a horizontal line.

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